

This is a continuation of applicant's earlier Application No. 09713382. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP §706.07(b).

Applicants note that MPEP §706.07(b) clearly states

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised. (Emphasis added.)

The present application is a continuing application filed as a Request for Continuing Examination (RCE) under 37 CFR §1.114. The RCE was necessary because Examiner Chang refused to enter Applicants' October 30, 2002 Amendment and Response under 37 CFR §1.116 (i.e., amendment filed after a final office action) into the record. See, Examiner Chang's Advisory Action, paper no. 11, wherein Examiner Chang refused to enter Applicants' October 30, 2002 Amendment and Response under 37 CFR §1.116 into the record because the proposed amendment raised new issues that would require further consideration and/or search.

Applicants filed the present RCE along with an Amendment and Response identical to Applicants' October 30, 2002 Amendment and Response under 37 CFR §1.116. Applicants respectfully submit that MPEP §706.07(b) makes it clear that Examiner Chang's final first Office Action in the present application is not proper since Examiner Chang refused to enter Applicants' October 30, 2002 Amendment and Response into the record.

For at least the reasons given above, Applicants submit that the finality of the May 14, 2003 Office Action is premature. Accordingly, Applicants respectfully request withdrawal of the finality of the present Office Action.

Allowable Subject Matter:

Applicants note with appreciation that claims 21-28 are objected to as being dependent upon a rejected claim, but would be allowable if rewritten in independent form. Applicants further note with appreciation that claims 29-30 are allowed. Applicants respectfully submit that the remaining pending claims of the present invention are also allowable for at least the reasons given below.

July 01, 2003 Telephone Interview:

Applicants appreciate Examiner Chang for spending a few minutes to discuss the present office action during a July 01, 2003 telephone interview. The pending claim rejections were discussed in the telephone interview. Applicants provide the following comments and remarks regarding the pending claim rejections.

II. Prior Art Rejections

Claim Rejections Under 35 U.S.C. §103(a)

Claims 11-20 are rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,284,360 issued to Johnson et al. (hereinafter "Johnson") in view of Japanese Patent Application Publication No. 10195393 issued to Sekisui Chemical Company (hereinafter "Sekisui '393"). This rejection is respectfully traversed.

As discussed in Applicants' April 14, 2003 Amendment and Response (paper no. 16), Johnson is not prior art to the present invention under 35 U.S.C. §103 via 35 U.S.C. §102(e) as a result of a change to 35 U.S.C. 103(c) effective November 29, 1999. The present application (i) is a continuing application filed under 37 CFR 1.53(b), (ii) has a filing date after November 29, 1999 (i.e., a filing date of November 15, 2000), and (iii) at the time the invention was made, was owned by the same person (or entity) as the Johnson patent (i.e., The 3M Company).

The change to 35 U.S.C. 103(c) clearly applies to the present application and the Johnson patent. As shown below, MPEP §706.02(I)(1) clearly states

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." **This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution applications filed under 37 CFR 1.53(d), and reissues.** (Emphasis added.)

In the May 14, 2003 Office Action, Examiner Chang states

First, the Examiner reiterate(s) that there is no assignee for US Application No. 09/713382 on the record. Second, US Application No. 09/713382 is a divisional application of US Application No. 09/409502, and neither 09/713382 nor 09/409502 is a continuing application of 08/941,430, of which the reference Johnson (US 6284360) is based upon. As such, Johnson is an appropriate prior art under 35 USC 103(a) to the instant claimed invention.

Applicants disagree on both points by Examiner Chang.

Applicants submit herewith a copy of the effective assignment recordation sheet for the present application. As shown by the attached recordation sheet, U.S. Patent Application Serial No. 09/409,520 was assigned to 3M Innovative Properties Company and recorded at Reel 010289, Frame 0167 on August 30, 1999. As discussed in the July 01, 2003 telephone interview, the present application is a divisional patent application of U.S. Patent Application Serial No. 09/409,520, claiming priority to U.S. Patent Application Serial No. 09/409,520, now U.S. Patent No. 6,316,099. The assignment of the present application to 3M Innovative Properties Company is effective via (i) the attached assignment recordation sheet and (ii) the assignment of U.S. Patent Application Serial No. 09/409,520 and "any divisional or continuation (in whole or in part) of said application" (see assignment language in attached assignment of U.S. Patent Application Serial No. 09/409,520 to 3M Innovative Properties Company).

However, it should be noted that the only evidence required to establish common ownership of the present application and Johnson is a statement by an attorney or agent of record that the present application and Johnson were, at the time of the invention was

made, owned by, or subject to an obligation of assignment to, the same person. See MPEP §706.02(l)(2)(II) entitled "Evidence Required To Establish Common Ownership."

The present application, U.S. Patent Application Serial No. 09/713,382, and U.S. Patent No. 6,284,360 issued to Johnson were, at the time of the invention of U.S. Patent Application Serial No. 09/713,382 was made, owned by 3M Innovative Properties Company.

Further, it should be noted that the change to 35 U.S.C. §103(c) does not require the present application to be a continuing application of the Johnson patent. The change to 35 U.S.C. §103(c) only requires (i) that the patented subject matter (i.e., Johnson) and the claimed invention (i.e., the present application) "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person¹," (ii) that the present application have a filing date on or after November 29, 1999, and (iii) that the present application be an utility patent application, a design patent application, a plant patent application, a continuing application filed under 37 CFR 1.53(b), a continued prosecution application filed under 37 CFR 1.53(d), or a reissue.

Clearly, Johnson is not prior art to the present invention under 35 U.S.C. §103 via 35 U.S.C. §102(e) as a result of a change to 35 U.S.C. 103(c) effective November 29, 1999. Accordingly, the rejection of claims 11-20 under 35 U.S.C. §103(a) as being obvious over Johnson in view of Sekisui '393 is improper.

Even If Johnson Was Prior Art Under 35 U.S.C. §103(a), Johnson In
Combination With Sekisui '393 Still Fails To Make Obvious Applicants'
Claimed Invention

Even if Johnson was considered prior art under 35 U.S.C. §103(a), the combined teaching of Johnson and Sekisui '393 fails to make obvious Applicants' claimed invention for at least the reasons given in papers nos. 10, 13 and 16.

¹ The term "person" refers to a person or organization. See MPEP §706.02(l)(2)(I) entitled "Definition Of Common Ownership" where "person" and "organization" are used interchangeably.

III. Conclusion:

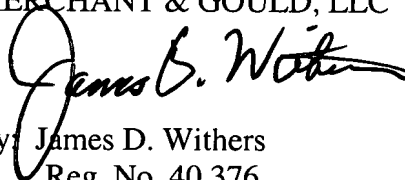
For at least the reasons given above, Applicants submit that claims 11-30 are in condition for allowance. Accordingly, Applicants respectfully request allowance of these claims.

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 10-1215.

Should the Examiner believe that anything further is necessary in order to place the application in better condition for allowance, the Examiner is respectfully requested to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,

MERCHANT & GOULD, LLC

A handwritten signature in black ink, appearing to read "James D. Withers", is written over the printed name and registration number.

By: James D. Withers
Reg. No. 40,376

MERCHANT & GOULD, LLC
3200 IDS Center
80 South 80th Street
Minneapolis, Minnesota 55402-2215
404/954-5038

Attorney No.: 07780.0820US01
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